

REMARKS

Claims 34 through 42 are pending in the application, and were finally rejected. Claims 34 through 42 were rejected. Applicants believe the claims as currently amended have been placed in a condition for allowance, and respectfully request the Examiner to reconsider and withdraw the rejection in view of the amendments.

REJECTION UNDER 35 U.S.C. § 103

Claims 34 - 42 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ponzi (U.S. Pat. No. 5,964,757). This rejection is respectfully traversed.

With respect to claims 34 and 35, these claims have been amended to further define the magnetic members disposed in the distal end of the catheter as being responsive to an externally applied magnetic field *to orient the magnet members and tip of the catheter*. These amendments do not introduce new structure or alter the structure of the claimed invention, and therefore do not introduce subject matter outside of the scope of the Examiner's search. Applicants further believe that the amendments place the claims in a condition for allowance, or at least for the purposes of appeal.

The Final Office Action states that Ponzi discloses one or more magnet members 72 disposed in the distal end of the catheter. However, the magnet member 72 disclosed in Ponzi is only a location sensor, and may not respond to an externally applied magnetic field to orient the tip of the catheter. While the magnetic member 72 disclosed in Ponzi may inherently be responsive to magnetic fields, such response could be a simple attraction by the gradient of the external magnet and may not orient the distal tip of the catheter in a desired direction. There is nothing inherent in the Ponzi magnet member that it would align with a magnetic field. Further, there is no indication that the Ponzi magnet member would respond to an externally applied magnetic field.

While the magnet member disclosed in Ponzi could possibly respond by movement resulting from simple attraction to the external magnet, it is well known that magnet attraction falls off with the fourth power of distance and movement may not be appreciable. Furthermore, the magnet member disclosed in Ponzi is likely not able to move or orient the distal tip, because the whole point of the Ponzi magnet member was to serve as a sensor to locate the tip. If the Ponzi magnet member moved when exposed to an externally applied magnetic field, an attempt to sense location of the magnet member via an external magnetic field would be self defeating.

As the Board of Patent Appeals and Interferences concluded in the Appeal Decision in the parent application (09/352,161), there must be evidence to reasonably support the determination that a magnet member in the distal end of a catheter inherently would be responsive to externally applied magnetic fields to orient the distal tip of the catheter. The mere fact that a certain thing may result from a given set of circumstances is not sufficient to support the determination that orientation is possible. Movement of the Ponzi magnet member, if at all possible, is not the same as orienting the distal tip, which the magnets (24, 432, 526, 618) in the present invention provide for. As such, Applicants believe that claims 34, 35 and 39 as currently amended are not obvious in view of Ponzi, and are in a condition for allowance.

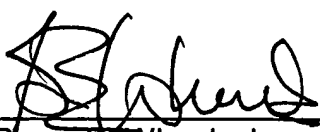
With respect to claims 36 through 38, these claims depend from claim 35, which applicants believe to be allowable as currently amended. Thus, for at least these reasons, Applicants submit that claims 36 through 38 are also in a condition for allowance.

With respect to claims 40 through 42, these claims depend from claim 39, which applicants believe to be allowable as currently amended. Thus, for at least these reasons, Applicants submit that claims 40 through 42 are also in a condition for allowance.

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants believe that a full and complete response has been made to place the application in a condition for allowance, and respectfully request that a timely Notice of Allowance be issued in this case. If it will advance the prosecution of this application, the examiner is invited to call the undersigned at (314) 726-7500.

Respectfully submitted,

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